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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,383	10/27/2003	Ekambar R. Kandimala	HYB-005US4	5766
7590 WAYNE A. KEOWN SUITE 1200 500 WEST CUMMINGS PARK WOBURN, MA 01801				
11/25/2009				
EXAMINER				
HORNING, MICHELLE S				
ART UNIT		PAPER NUMBER		
1648				
MAIL DATE		DELIVERY MODE		
11/25/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/694,383

**Applicant(s)**

KANDIMALLA ET AL.

**Examiner**

MICHELLE HORNING

**Art Unit**

1648

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 12, 14, 39 and 40.  
Claim(s) withdrawn from consideration: 15-19.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Zachariah Lucas/  
Primary Examiner, Art Unit 1648

/M. H./  
Examiner, Art Unit 1648

Continuation of 11, does NOT place the application in condition for allowance because: Applicant first argues the validity of the finality being necessitated by amendment. This is not found persuasive as the previous amendment canceled the amine linker from the instant claims. Applicant asserts that this cancellation of the amine linker is not relevant to the previous art rejection because the instantly claimed linker replaces a nucleoside, as seen by Figures 9 and 10 of the instant application. This is not found persuasive because this is not a claim limitation. What may be shown in the figures is not read into the claims. The claims were properly rejected under prior art as the claims did not require the replacement asserted by applicant, as shown by Figures 9 and 10. Since the claims were properly rejected in the non-final, the cancellation of the amine linker properly necessitated the new grounds of rejection.

Applicant asserts that Cook and Weiner teach a nucleotide and not a modified nucleoside due to the presence of a phosphorous linkage. This is not found persuasive. The difference between a nucleotide and nucleoside is the presence of the "phosphate" backbone. The Cook and Weiner references teach a "phosphothioate" linkage. Therefore, due to the presence of sulfur in the phosphothioate, this moiety is not limited to a nucleotide, but reads on a modified nucleoside, e.g., a cytosine being modified with a phosphothioate. Additionally, the figures cited by applicant, Figures 9 and 10 are drawn to "Oligonucleotides" (see heading), thus do not specifically exclude a phosphate. Also, broadly read, a nucleotide comprises a nucleoside. Even the X in applicants figure 9 shows a phosphothioate, thus it unclear how applicant can differentiate this moiety over the prior art. Applicant also asserts that the phosphothioate does not read on applicants immunostimulatory moiety. This is not found persuasive because Cook discloses 1'-2'-dideoxyribose which reads on applicants immunostimulatory moiety. The recitation by the examiner concerning the immunostimulatory aspect was to capture that since Cook teaches that the phosphothioate moiety is also immunostimulatory, the recitation of "immunostimulatory oligonucleotide" in the preamble must be met by Cook.

Applicant further asserts the nucleoside/nucleotide difference of the instant claims as compared to Weiner. However, this does not comport with what is shown by applicant's figures, as the X moiety in Figure 9 includes a phosphothioate moiety.

Applicant further asserts that Cook does not disclose that 4-thiouracil renders an oligonucleotide more resistant to nucleases. This is not found persuasive as the prior art need not teach the same advantage as asserted by applicant. Also, this is a functional characteristic and the same compounds must have the same properties.

The obvious double patenting rejections are maintained. Applicant's reference to MPEP 804.B1 is not pertinent at this time as the application is not being passed to issue. Also, the assertion that the double patenting rejection over '286 patent should not be maintained is not persuasive since the instant claims are not limited to 1',2'dideoxyribose or a phosphothioate and the claims encompass a phosphothioate.